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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,211	01/22/2007	Wilfried Lubisch	ABB10010P0912US	5690

32116 7590 09/11/2008  
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
500 W. MADISON STREET  
SUITE 3800  
CHICAGO, IL 60661

EXAMINER

CHANDRAKUMAR, NIZAL S

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

09/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/574,211

**Applicant(s)**

LUBISCH ET AL.

**Examiner**

NIZAL S. CHANDRAKUMAR

**Art Unit**

1625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,11,13-17 and 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-3, 6-10,18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
- Paper No(s)/Mail Date 03/30/2008.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Group 7 (claims 1-10 and 18) drawn to compounds of the following core structure

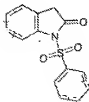


in the reply filed on 06/11/2008 is acknowledged. The traversal is on the ground(s) that

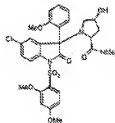
a) Group 7 (compound claims) and Group 20 (method of treating various diseases) relate to single general inventive concept because Group 20 relate to the use of compounds of Group 7

b) compounds of Groups 5 to 7 relate to a single inventive concept.

This is not found persuasive because the invariant structural moiety to all the claims is known in the prior art compounds for the same therapeutic use, as shown below:



Invariant in the instant claim



prior art

The requirement is still deemed proper and is therefore made FINAL.

Claims 11,13-17, 19-31 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions. there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06/11/2008.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims prosecuted:

Applicant did not identify the claims reading on the elected subject matter, as requested in the office action filed 05/08/2008, page 6, lines 9-10.

Examiner identified claims 1-3, 6-10, 18 as reading on the elected Group 7.

Claims 1-3, 6-10, 18 are prosecuted to the extent that they read on the elected subject matter.

**Telephonic conversation 312 627 2184:**

On 07/30/2008 Lisa Muller attorney for the applicant, was advised of the rejoinder provision. Applicant authorized the cancellation of non-elected withdrawn claims 11,13-17, 19-31.

Accordingly claims 11, 13-17 and 19-31 are rejoined. The Election/Restriction of 05/08/2008 is maintained and claims 4,5, 11, 13-17 and 19-31 are cancelled.

### **Quayle Action**

This application is in condition for allowance except for the following formal matters:

Claims 1-3, 6-10, 18 are objected to for having non-elected subject matter.

**Examples** of non-elected subject matter:

Example 1: Claim 1, the definition of variable A includes terms corresponding to non-elected subject matter "or an aromatic or partially aromatic heterobicyclic ring,"

Example 2: Claim 1, variable R5 includes terms other than NR4, NR54-(C1-C4-alkylene)

Example 3: Claim 3, line 2, term corresponding to non-elected subject matter benzothiazole

The required amendments are too-many.

Also claims 4 and 5 correspond to non-elected subject matter and needs to be deleted.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

The following is an examiner's statement of reasons for allowance:

The following is a statement of reasons for the indication of allowable subject matter: A structure search for the instantly elected group of compounds provides no hit. The closest prior art (Roux et al, WO /01/98295 A1, see Abstract) teaches compounds corresponding to instant formula wherein the compounds are characterized by an aromatic substitution at the 3-position of the indolone ring while the instant compounds have monocyclic heteroaromatic at the 3-position of the indolone ring system. There is no suggestion, motivation or teaching in the prior art for making or using compounds of the instant claims. The specification is enabling for making and using instantly claimed compounds.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAL S. CHANDRAKUMAR whose telephone number is (571)272-6202. The examiner can normally be reached on 8.30 AM - 4.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571 0272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nizal S. Chandrakumar

/D. Margaret Seaman/  
Primary Examiner, Art Unit 1625